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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,954	04/02/2004	Tord Inghardt	3764-155	8926
23117	7590	07/06/2006		EXAMINER
NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203				SAEED, KAMAL A
			ART UNIT	PAPER NUMBER
			1626	

DATE MAILED: 07/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/815,954	INGHARDT ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Kamal A. Saeed	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,2,4-13 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) 21-24 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2 and 4-13 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. 09/509,032.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/2/04</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: ____.                                    |

***DETAILED ACTION***

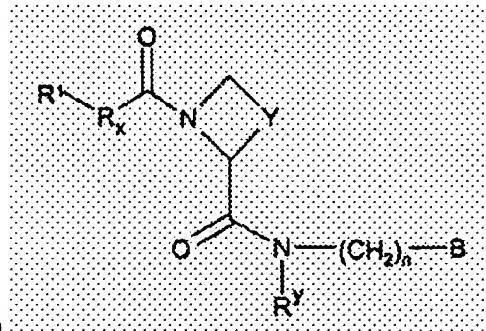
Claims 3 and 14-20 have been cancelled. Therefore, claims 1, 2, 4-13 and 21-24 are currently pending in the instant application. Claims 21-24 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

***Information Disclosure Statement***

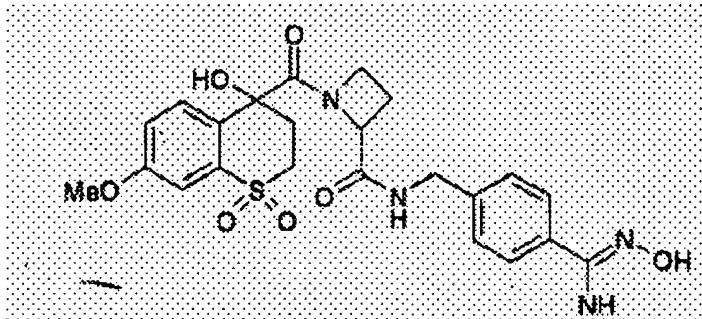
Applicant's Information Disclosure Statements, filed on 10 March 2004 has been considered. Please refer to Applicant's copy of the 1449 submitted herewith.

***Response to Restriction***

Applicant's election of Group I, claims 1, 2 and 4-13 (all claims in part), drawn to



compounds of structural formula as depicted in claim 1,

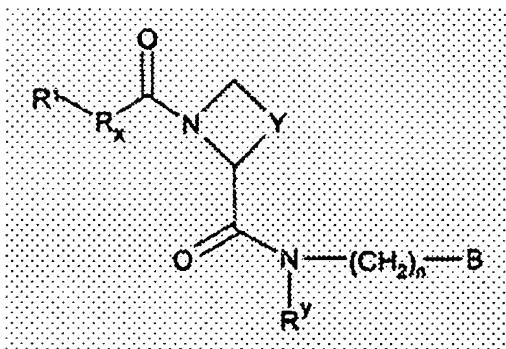


and the specific compound, in response filed on claim 17 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). As far as the method of use claims are concerned, In

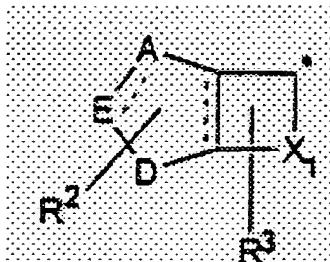
accordance with M.P.E.P. 821.04 and In re Ochiai, 71 F.3d 1565, 37 USPQ 1127 (Fed. Cir. 1995), rejoinder of product claims and method of use claims commensurate in scope with the allowed product claims will occur following a finding that the product claims are allowable. Until such time, a restriction between product claims and process is deemed proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

*The elected and examined subject matter is as follows :* The compounds of Formula I,



, of claim 1, wherein: R<sup>1</sup> is as defined; R<sub>X</sub> is represents



*formula IIa*

*wherein*

the dotted double lines in the requisite fragment of formula IIa both represent double bonds;

A and E both represent CH;

D represents -CH=CH-;

A<sup>3</sup> represents C, alkylene (i.e. methylene);

m represents 2;

R<sup>2</sup> represents C, alkoxy (i.e. methoxy; and is substituted at the position indicated above);

the optional substituted R<sup>3</sup> is not present;

Y represents -CH<sub>2</sub>;

R<sup>7</sup> represents H;

B represents a structural fragment of formula IIIa;

X<sup>5</sup>, X<sup>6</sup>, X<sup>7</sup> and X<sup>8</sup> all represent CH;

the optional substituent R<sup>31</sup> is not present;

D<sup>2</sup> represents H and D<sup>1</sup> represents OR<sup>d</sup>; and

R<sup>8</sup> represents H.

Art Unit: 1626

The search was further extended to include the compounds of Formula I, wherein B represents a structural fragment of Formula IIIc; X<sub>1</sub> is as defined; Z is as defined; R<sup>y</sup> is as defined; one of D<sup>1</sup> and D<sup>2</sup> represents H, and the other represents H, OR<sup>a</sup> or NHR<sup>a</sup>.

As a result of the election and the corresponding scope of the invention identified supra, the remaining subject matter of claims 1,2 and 4-13 are withdrawn from further consideration pursuant to 37 CFR 1.142 (b) as being drawn to non-elected inventions. The withdrawn compounds contain varying functional groups such as pyrimidinyl; piperidinyl; imidazolyl, pyrrolidinyl etc, which are chemically recognized to differ in structure and function. This recognized chemical diversity of the functional groups can be seen by the various classification of these functional groups in the U.S. classification system, i.e. class 544 subclass 224(+) (dizziness), class 546 subclass 184(+) (piperdines), 546 subclass 249(+) (pyridines) etc. Therefore the subject matter which are withdrawn from consideration as being non-elected subject differ materially in structure and composition and have been restricted properly a reference which anticipated but the elected subject matter would not even render obvious the withdrawn subject matter and the fields of search are not co-extensive.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

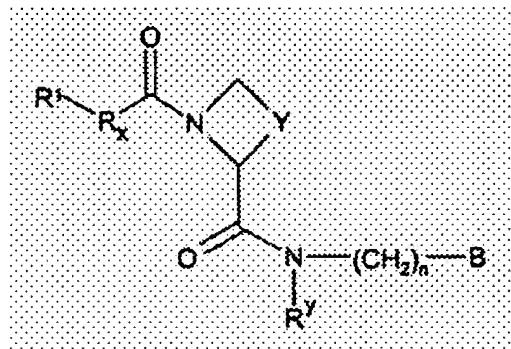
Art Unit: 1626

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

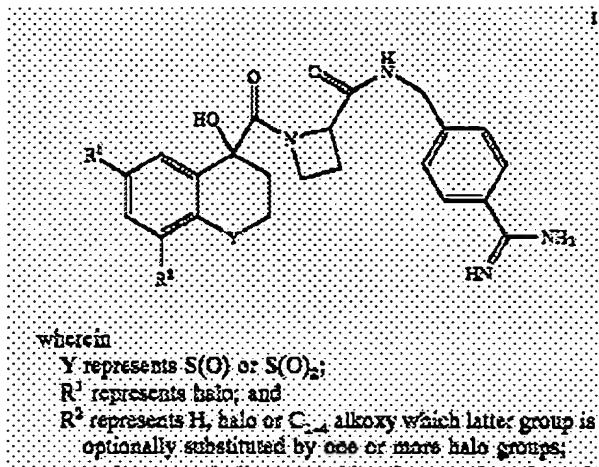
A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1,2 and 4-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 8, 9 and 12 of U.S. Patent No. 6,716,834 to Andersson et al.. Instant claims disclose compounds or a salt of the compound of the formula



depicted in claim 1, as defined above. US Patent No.



wherein

Y represents S(O) or S(O)<sub>2</sub>;

R<sup>1</sup> represents halo; and

R<sup>2</sup> represents H, halo or C<sub>1-4</sub> alkoxy which latter group is optionally substituted by one or more halo groups,

or a pharmaceutically acceptable salt or prodrug thereof.

teach in claim 1, compounds of formula I. In claim

8 the patent teach the pharmaceutical compositions. Claim 9 of the patent teach specific configuration of the fragment which is the same as claim 12 of this application. Although the conflicting claims are not identical, they are not patentably distinct from each other because US Patent No. 6,716,834 which discloses specific compounds and salts (see claims 1-5) which are more specific embodiments that anticipate the compounds and salts as instantly claimed and one skilled in the art would have been motivated to make specific compounds similar to the one described and exemplified in US Patent No. 6,716,834.

### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamal Saeed whose telephone number is (703) 308-4592. The examiner can normally be reached on Monday-Friday from 8:00 AM – 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308 4537. The unofficial fax phone for this group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communication via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-2286.



KAMAL A. SAEED, PH.D.  
PRIMARY EXAMINER